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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/612,067

07/07/2000

Joel Naumann

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6900

7590

06/24/2005

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EXAMINER

KADING, JOSHUA A

ART UNIT

PAPER NUMBER

2661

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/612,067

Applicant(s)

NAUMANN, JOEL

Examiner

Joshua Kading

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-10 and 12-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10 and 12-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-10, 12-21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (AAPA) in view of U.S. Patent 5,923,663, Bontemps et al. (Bontemps).

In regard to claims 1, 10, and 18, AAPA discloses "an apparatus for detecting the absence of a LAN or WAN compliant device, said apparatus comprising: a PCI-compliant front card, said front card being configured to accept a LAN or WAN compliant back card (*Background section of the specification and figures 1 and 2*)..."

However, AAPA lacks what Bontemps discloses, "said front card further having a switch, said switch being a tri-state buffer and being serially disposed on a IDSEL connection corresponding to a particular channel on said front card, said switch being further configured to receive a sensing signal corresponding to said channel from said device by switching input of said tri-state buffer (*figure 2, element 222 and figure 4 where element 222 is the function equivalent of the tri-state buffer by allowing a select signal to be asserted when a device is detected as can be read in col. 11, lines 25-38*); and wherein said apparatus is configured to couple said IDSEL connection to said front

Art Unit: 2661

card if said sensing signal is in a first state, and provide a low potential to said front card if said sensing signal is in a second state (*col. 11, lines 25-38; it is noted that although Bontemps does not disclose the sensing signal to be low when the select signal is coupled, it is a matter of design choice how the sensing signal is interpreted because there are only two states and if one state, such as low, affects the response of coupling, then the other state, in this case high, will result in the decoupling or opposite response; it is also noted that although the "toggle state" of Bontemps is not consistently providing a "logical low" in response to a given state of the sensing line, it is providing the same effect of decoupling the select line).*"

It would have been obvious to one with ordinary skill in the art at the time of invention to include the "tri-state buffer" and the "coupling of the IDSEL line" with the front and back cards of AAPA for the purpose of allowing detection of devices to a port. The motivation being quicker establishment of communication links through detected devices by eliminating a "trial and error" approach to appropriately connecting devices.

In regard to claim 3, AAPA lacks what Bontemps further discloses, "said tri-state buffer further has an input and an output, said input and output being serially disposed on a IDSEL line corresponding to a particular channel (*figure 2, element 22 and figure 4, where the input and outputs of element 222 are serially disposed on a particular channel corresponding to a particular port*)." It would have been obvious to one with ordinary skill in the art at the time of invention to include the input and output of the tri-

Art Unit: 2661

state buffer with the method of claim 1 for the same reasons and motivation as in claim 1.

In regard to claims 4, 12, and 19, Bontemps lacks what AAPA further discloses, "said front card comprises and FE MAC, and said back card comprises an FE Phy (*figure 1, elements 100 and 101*).” It would have been obvious to one with ordinary skill in the art at the time of invention to include the FE MAC and FE Phy for the same reasons and motivation as in claims 1, 10, and 18.

In regard to claims 5, 13, and 20, Bontemps lacks what AAPA further discloses, "said front card and said back card are coupled via an MII bus (*figure 2, element 114*).” It would have been obvious to one with ordinary skill in the art at the time of invention to include the MII bus for the same reasons and motivation as in claims 4, 12, and 18.

In regard to claims 6, 14, and 21, AAPA and Bontemps lack "said front card comprises an HDLC control, and said back card comprises a T1/E1 framer [or] line interface.” Although both AAPA and Bontemps lack "the HDLC control" and "T1/E1 framer or line interface", it would have been obvious to one with ordinary skill in the art to include these with the method of claim 1 as a matter of design choice. As can be seen in applicant's specification, page 15, lines 5-13 these devices are chosen based on the type of network or on requirements for communication and not chosen based on applicant's invention. Therefore, choosing HDLC control versus ATM SAR (as can be

Art Unit: 2661

seen in Table 1) is a matter of design choice. The motivation for choosing the different devices would be based on the type of network and the requirements needed for communication.

In regard to claims 7, 15, and 22, AAPA and Bontemps lack "said front card and said back card are coupled via a TDM bus." Although both AAPA and Bontemps lack "said front card and said back card are coupled via a TDM bus", it would have been obvious to one with ordinary skill in the art to include this with the method of claim 6 as a matter of design choice. As can be seen in applicant's specification, page 15, lines 5-13 these coupling means are chosen based on the type of network or on requirements for communication and not chosen based on applicant's invention. Therefore, choosing a TDM bus versus a MII bus (as can be seen in Table 1) is a matter of design choice. The motivation for choosing the different bus would be based on the type of network and the requirements needed for communication.

In regard to claims 8, 16, and 23, AAPA and Bontemps lack "said front card comprises an ATM SAR, and said back card comprises an ATM Phy." Although both AAPA and Bontemps lack "the ATM SAR" and "ATM Phy", it would have been obvious to one with ordinary skill in the art to include these with the method of claim 1 as a matter of design choice. As can be seen in applicant's specification, page 15, lines 5-13 these devices are chosen based on the type of network or on requirements for communication and not chosen based on applicant's invention. Therefore, choosing

Art Unit: 2661

ATM SAR versus HDLC control (as can be seen in Table 1) is a matter of design choice. The motivation for choosing the different devices would be based on the type of network and the requirements needed for communication.

In regard to claims 9, 17, and 24, AAPA and Bontemps lack "said front card and said back card are coupled via a Utopia bus." Although both AAPA and Bontemps lack "said front card and said back card are coupled via a Utopia bus", it would have been obvious to one with ordinary skill in the art to include this with the method of claim 8 as a matter of design choice. As can be seen in applicant's specification, page 15, lines 5-13 these coupling means are chosen based on the type of network or on requirements for communication and not chosen based on applicant's invention. Therefore, choosing a Utopia bus versus a MII bus (as can be seen in Table 1) is a matter of design choice. The motivation for choosing the different bus would be based on the type of network and the requirements needed for communication.

### ***Response to Arguments***

3. Applicant's arguments filed 12 April 2005 have been fully considered but they are not persuasive.

Applicant makes the following arguments as to why applicant's admitted prior art (AAPA) in view of Bontemps does not read on the claimed invention:

1) "Bontemps does not teach communication between a PCI-compliant front card configured to accept a LAN or WAN compliant back card, thus utilizing IDSEL signaling

Art Unit: 2661

between the front card and back card," and applicant demands proof from the examiner that the cards of Bontemps automatically support a LAN or WAN compliant back card.

2) "Bontemps' use of XOVER\_SEL signal is not equivalent of how the present invention uses [an] IDSEL signal."

3) "There is no implicit disclosure of PCI-compliant front cards having MACS located thereon in Bontemps," and applicant further demands proof that Bontemps can be extended to a PCI-compliant front card having a MAC located thereon.

4) AAPA in view of Bontemps must arrive at applicant's invention and since there is no motivation to combine Bontemps with AAPA this requirement is not met.

The examiner respectfully disagrees.

The following are reasons as to why AAPA in view of Bontemps fully reads on applicant's claimed invention:

1) As noted in the rejections above, AAPA is used to read on applicant's claimed PCI-compliant cards. These are seen in the specification, figure 2. However, Bontemps does in fact support the use of the invention within a LAN, see col. 2, lines 1-5 where the Ethernet is a LAN and col. 5, lines 66-col. 67, lines 1-3 further support the use of the invention of Bontemps in a LAN. Therefore, the invention used in Bontemps to read on applicant's invention is of analogous art that is combinable within the context of applicant's invention. Applicant should further note that is not necessarily a requirement of 35 U.S.C. 103 that the inventions of the combined references be physically combinable (i.e. the secondary reference does not need to disclose all or certain

Art Unit: 2661

features of the primary reference to be combinable, this is the reason the references are combined for the obvious type rejection). As long as the combination does not destroy or contradict either reference, they are combinable. See MPEP § 2145.III. Therefore, applicant is asked to show how the LAN device of Bontemps destroys or contradicts the teachings of AAPA so as to prohibit their combination.

2) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Bontemps' use of the XOVER\_SEL signal is not equivalent of how the present invention uses it) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3) Again, the fact that Bontemps does not necessarily disclose a PCI-compliant front card having MACS does not mean it cannot be combined with AAPA. As noted in the rejections above, AAPA is used to disclose the feature of the FE MAC on the front card. However, it should be further noted that Bontemps does communicate with MAC cards as seen in figure 2.

4) Bontemps, col. 3, lines 66-col. 4, lines 1-4 provides the support for the offered motivation in the above rejections.

### **Conclusion**

4. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the

Art Unit: 2661

grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

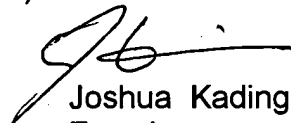
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Kading whose telephone number is (571) 272-3070. The examiner can normally be reached on M-F: 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (571) 272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

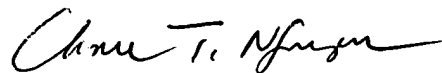
Art Unit: 2661

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joshua Kading  
Examiner  
Art Unit 2661

June 21, 2005



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